

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	LINDA ANN ROBERTS et al.)	
)	Group Art Unit: 2461
Serial No.:	09/855,804)	
)	Examiner: Mattis
Filed:	May 16, 2001)	
)	
For:	PRIORITY CALLER ALERT)	

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Commissioner for Patents
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Final Office Action mailed October 18, 2010, and in conjunction with the concurrently filed Notice of Appeal, Assignee requests a Pre-Appeal Brief Conference in view of the following remarks.

REMARKS

In response to the final Office Action dated October 18, 2010, Assignee respectfully request reconsideration in a Pre-Appeal Brief Conference based on the following remarks. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Claims 1-3, 5-8, 11-18, 21, 23-25 and 29 were rejected under 35 U.S.C. § 103 as being unpatentable over Dolan in view of Leung and Hoopes. This rejection is traversed for the following reasons.

Embodiments of the invention relate to alerting a called subscriber that a priority caller is calling. As recited in claim 1, a service control point determines a priority caller in response to a priority code submitted by the priority caller, the priority code being a subscriber generated code provided to a plurality of priority callers. If a caller is identified as a priority caller, then a priority response is used which includes an action to ring a telephone associated with the telephone line with an alert signal that is different from a regular ringing tone.

Claim 1 recites “a priority response comprising an action to ring a telephone associated with the telephone line with an alert signal that is different from a regular ringing tone.” In applying Dolan, the Office Action acknowledges that Dolan fails to disclose this feature and relies on Hoopes for disclosing a priority alert ring. Assignee submits that it would not have been obvious to include ringing a telephone with a priority alert signal in the system of Dolan.

Figure 11 of Dolan describes how a subscriber handles a call based on caller priorities (column 5, lines 55-67). As shown in Figure 11, the incoming call is answered only if the caller's priority is sufficient. If the caller's priority is sufficient, the called party subscriber is alerted to the call and makes a decision about how to handle the call. In receiving an incoming call in Dolan, the system determines if the caller has sufficient priority prior to notifying the subscriber. Thus, there is no need for a “priority alert ring” in Dolan as all calls connected to the subscriber have already been screened to determine if the caller has sufficient priority. A priority alert ring is not needed in Dolan as the priority decision has already been made before the call is routed to the subscriber. A priority alert ring would be redundant and unnecessary in Dolan as callers lacking the requisite priority are not connected

to the subscriber. Therefore, there is no reason to use a priority alert ring in Dolan. Accordingly, there is insufficient motivation to combine Dolan and Hoopes as proposed by the Examiner.

Furthermore, Dolan discloses that if a caller's priority level exceeds the subscriber's monitor-availability level, then permitting the subscriber to monitor a message from the caller audibly over the Internet (Figure 11, step 83). The audible message from the caller is used to aid the subscriber in making a decision for handling the call (column 5, lines 43-51). The Office Action proposes replaces the audible message of Dolan with a priority alert ring of Hoopes. To do this would alter the principle of operation of Dolan. The PTO *Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex* state that "the 'predictable result' discussed in KSR refers not only to the expectation that prior art elements are capable of being physically combined, but also that the combination would have worked for its intended purpose." Replacing the audible message from the caller in Dolan with a priority alert ring of Hoopes would eliminate the ability of the called party to make a decision about handling an incoming call. This results in Dolan being modified in such a way that the system of Dolan no longer operates for its intended purpose of allowing called parties to effectively screen calls. Accordingly, the proposed modification of Dolan is improper. Leung was relied upon as disclosing a subscriber provided priority code, but fails to cure the deficiencies of Dolan and Hoopes.

For at least the above reasons, claim 1 is patentable over Dolan in view of Leung and Hoopes. Claims 2, 3 and 5-8 depend from claim 1 and are patentable over Dolan in view of Leung and Hoopes for at least the reasons advanced with reference to claim 1.

Claim 11 recites "executing a priority action if the incoming call comprises the priority caller information, wherein the priority action comprises ringing a telephone associated with the telephone line with a priority alert signal that is different from a regular ringing tone." As discussed above, the combination of Dolan in view of Leung and Hoopes fails to disclose these features. Claims 12 and 13 depend from claim 11 and are patentable over Dolan in view of Leung and Hoopes for at least the same reasons.

Claim 14 recites "executing the priority action if the incoming call comprises the at least one priority caller number, the priority action comprising an action to ring a telephone associated with the telephone line with an alert signal that is different from a regular ringing

tone.” As discussed above, the combination of Dolan in view of Leung and Hoopes fails to disclose these features. Claims 15-18 depend from claim 14 and are patentable over Dolan in view of Leung and Hoopes for at least the same reasons.

Claim 21 recites “executing the priority action if the priority code matches one of the at least one priority codes, the priority action comprising an action to alert the terminating equipment associated with the telephone line with a priority alert signal that is different from a regular ringing tone, the terminating equipment comprising a telephone and a computer.” As discussed above, the combination of Dolan in view of Leung and Hoopes fails to disclose these features. Claims 23-25 depend from claim 21 and are patentable over Dolan in view of Shaffer and Hoopes for at least the same reasons.

Claim 29 recites “executing the priority action according to the calling party information, the priority action comprises an action to alert the terminating equipment associated with the telephone line with a priority alert signal that is different from a regular ringing tone, the terminating equipment comprising a telephone and the computer.” As discussed above, the combination of Dolan in view of Leung and Hoopes fails to disclose these features.

Claims 9-10, 19-20 and 26-27 were rejected under 35 U.S.C. § 103 as being unpatentable over Dolan in view of Leung and Hoopes and Taylor. This rejection is traversed for the following reasons.

Taylor was relied upon for allegedly disclosing TCP/IP and VoIP telephony, but fails to cure the deficiencies of Dolan in view of Leung and Hoopes discussed above with reference to claims 1, 14 and 21. Taylor does not disclose the use of an alert signal for priority calls or a priority code being a subscriber generated code provided to a plurality of priority callers. Claims 9-10 depend from claim 1, claims 19-20 depend from claim 14 and claims 26-27 depend from claim 21 and are patentable over Dolan in view of Leung and Hoopes and Taylor for at least the reasons advanced with reference to claims 1, 14 and 21.

In view of the foregoing, it is respectfully requested that the outstanding rejections be withdrawn and that a Notice of Allowance be issued. If the Examiner believes that a telephone conference with the undersigned would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees

to be due in connection with this application, the undersigned hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

If any extensions of time are required under 37 C.F.R. 1.136, Assignee hereby petitions for such extensions of time and authorize any extension fees to be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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